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| 09/332,760 | 06/14/1999 | DOUGLAS CLAFFEY | | 3302 |

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EXAMINER

JONES, HUGH M

ART UNIT PAPER NUMBER

2123

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/332,760

Applicant(s)
Claffey et al.

Examiner
Hugh Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 22, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 23-26, and 30-35 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 23-26, and 30-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Introduction

1. Claims 1-18, 23-26, 30-35 of U. S. Application 09/332,760 filed on 06-14-1999, are presented for examination. Please note the Requirement for Information under 37 C.F.R. 1.105.

Specification

2. The amendment filed 6/28/2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicants have deleted the incorporation by reference of Satellite Tool Kit systems analysis program, cert. Nos. TX4-819-009, TX4-819-010 and TX4-819-011. This is new matter in so far as it changes the scope of the specification and therefore the scope of the claims. Furthermore, the incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. ***Applicant is required to amend the disclosure to include the material incorporated by reference.*** The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

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Information Disclosure Statement

3. Applicants are thanked for providing the Information Disclosure Statement.

Claim Rejections - 35 USC §.112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 1-18, 23-26 and 30-35 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.**

- Applicants have only disclosed generalities of the claimed invention. There is no detailed disclosure relating to any of the claim limitations. It appears that a reader would have to reinvent the invention in so far as undo experimentation would be required to make and/or use the invention.

Claim Interpretations

6. The broadest reasonable interpretation has been given to the claims. The Examiner interprets that the application of image analysis to satellite sensor obscuration refers to intended use for the image analysis. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably

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distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

8. A person shall be entitled to a patent unless -

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (f) he did not himself invent the subject matter sought to be patented.

9. Claims 1-18, 23-26 and 30-35 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by STK version 3.0 or STK version 4.0.5 or "Sensor Obscuration Tool (STK/Advanced VO)" or Satellite Tool Kit systems analysis program, cert. Nos. TX4-819-009 (pp. 19-20), TX4-819-010 (pp. 19-20) or TX4-819-011 (pp. 20-21). Applicants have stated that (first full paragraph, paper # 8):

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“At the time of filing of this application, the invention was already being sold to customers as part of a working software product.” Applicants have not stated when the cited versions were on sale.

10. Claims 1-18, 23-26 and 30-35 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention, namely Satellite Tool Kit systems analysis program, cert. Nos. TX4-819-009 (pp. 19-20), TX4-819-010 (pp. 19-20) or TX4-819-011 (pp. 20-21). Applicants have stated that (first full paragraph, paper # 8):

“At the time of filing of this application, the invention was already being sold to customers as part of a working software product.” Applicants have not stated when the cited versions were on sale and whether the listed inventors are responsible for the *cited versions* of the *specifically cited* software product.

11. Claims 1-18, 23-26 and 30-35 are rejected under 35 U.S.C. 102(f) as being clearly anticipated by STK version 3.0 or STK version 4.0.5 or “Sensor Obscuration Tool (STK/Advanced VO)” or Satellite Tool Kit systems analysis program, cert. Nos. TX4-819-009 (pp. 19-20), TX4-819-010 (pp. 19-20) or TX4-819-011 (pp. 20-21). Applicants have stated that (first full paragraph, paper # 8):

“At the time of filing of this application, the invention was already being sold to customers as part of a working software product.”

- However, Applicants have not stated whether the listed inventors are responsible for the *cited versions* of the *specifically cited* working software product.

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Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or

unobviousness.

14. **Claim 1-18, 23-26, 30-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Claffey et al. (5,864,489 - of record) in view of Applicant's Own Admission *or* (Blank *or* Cok).**

15. Claffey et al. disclose *a three-dimensional visualization wherein the general concept of how to carry out object selection is taught (col. 3, lines 54-59); how to assign a color to selected relevant objects, while another color is assigned to irrelevant objects and background (col. 3, lines 49-55).* Claffey et al. further disclose a method and apparatus for modeling the exposure of

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spacecraft-mounted solar power panels to the sun over a given time interval, such as an orbit period, and a method and apparatus for modeling the drag of spacecraft over a given time interval, such as an orbit period. The result of the exposure modeling can be used to determine varying availability of electrical power for operations to be performed by the spacecraft and on-board apparatus. The results of the drag over time are used to predict orbit decay and fuel requirements for orbit maintenance and station-keeping. *The invention uses a graphically based satellite systems analysis program to approximate exposure and drag data through visual projection of the relevant spacecraft elements on a computer display screen.*

16. Claffey et al. does not disclose calculation of sensor obscuration.

17. Applicants have admitted (page 2, lines 17-23 - specification) that calculation of sensor obscuration is known prior art.

18. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of Claffey et al. to incorporate the teaching of sensor obscuration so as to increase the apparent sensor resolution and field of view of a satellite sensor by deleting obscuring objects.

19. Cok discloses a method and system that *obscures image features in a region of interest designated by a user*. An operator designates a special shaped region of interest and a computer convolves a specially designed kernel with the image data in the region. The kernel is designed to pull features outside the region into the region while combining the information within the region with the information pulled from outside. The kernel can be designed to correspond to the shape

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of the region for efficient computation. Once the region of interest is obscured the image is printed resulting in a print that *does not include undesirable features*. See col. 3-4; col. 6.

20. Blank discloses a system and method for editing digital images in three dimensions includes a computer for storing a digital image of an object and a background, as well as at least one additional background image. Based upon the difference between the hues of the edge of the object and the surrounding background and a predetermined hue difference, the computer locates the edge of the object and removes portions of the image (i.e., the background) that are outside the edge. Then, the object can be combined with a preselected one of the other background images so as to form a composite image. Components of the preselected background image are assigned relative positions in the X-Y plane, and are also assigned a value defining their location in one of a plurality of layers which form the Z dimension of the image. The object to be combined with the background is also assigned a value defining its location in at least one of those layers. In another embodiment of the invention, colors of either a digital or video image can be selectively assigned to a mask. The colors can be of the entire image or from a selected area of the image. Color manipulation can then be performed on just the colors of the image defined by the mask. The mask may be used with the entire image, with a selected area of the image, or with objects. Alternatively, the colors of the image defined by an inverted mask are affected by color manipulation. See fig. 4-5, 8-9, 12-15, 21-23 and corresponding text.
21. Blank or Cok teach image editing including calculation of obscuration by selected objects, but do not disclose obscuration calculations *for use* on satellite sensors.

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22. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of Blank or Cok to incorporate the teaching of sensor obscuration because Applicants have admitted (page 2, lines 17-23 - specification) that calculation of sensor obscuration is known prior art. Furthermore, Applying the teachings of Blank or Cok to Satellite sensor obscuration amounts to mere intended use of the teaching of Blank or Cok. Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Blank or Cok to incorporate the teaching of sensor obscuration so as to increase the apparent sensor resolution and field of view of a satellite sensor by deleting obscuring objects.

Response to Argument

23. Applicant's arguments filed 4/22/2003 have been fully considered but they are not persuasive.

Response to Argument - Objection to the Specification

24. Applicant's arguments filed 4/22/2003 have been fully considered but they are not fully persuasive. Applicants rely on the Declaration in support of their arguments that the previously incorporated material which they have subsequently attempted to delete should not be considered essential. It is noted that the Declaration relies, in part, upon the STK User's Manual: Versions 3.0 and 4.0.5 (page 3 and especially page 6 - beginning at line 2). The Declaration refers to numerous pages in the two STK manuals, thus rendering such disclosure essential. In so far as it would be a financial burden for the public to obtain copies of the software, said originally

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incorporated material must remain incorporated and, because it consists of non-patent literature, must be physically incorporated.

25. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. *Applicant is required to amend the disclosure to include the material incorporated by reference.* The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Response to Argument - 112 Rejections

26. Applicant's arguments filed 4/22/2003 have been fully considered but they are not fully persuasive.

27. The written description rejection is withdrawn. See Satellite Tool Kit systems analysis program, cert. Nos. TX4-819-009 (pp. 19-20), TX4-819-010 (pp. 19-20) or TX4-819-011 (pp. 20-21).

28. Applicant's arguments regarding the enablement requirement are not persuasive.

29. Applicant's arguments (pg. 21, paper # 8) that the material is non-essential is conclusory and based on circular reasoning. Applicants are reminded that argument does not replace evidence

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where evidence is necessary. Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See MPEP § 2129 and § 2144.03 for a discussion of admissions as prior art. The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) (“An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness.”). See MPEP § 716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration. Applicants also demurred that submission of the incorporated material would not appear to be “probative” of the enablement issue but fail to explain why. The Examiner again maintains that such submission is indeed probative and refers Applicants to MPEP section 2164.01(a) (Undo Experimentation Factors). Applicants refer to the Declaration in support of their arguments.

30. The Examiner has carefully considered the arguments in the Declaration but they are not persuasive. In general, the Declaration refers to only 2-3 lines in various sections of the application. The Examiner has carefully considered the indicated material but is not persuaded. This is insufficient detail.

31. It is noted that the Declaration relies, in part, upon the STK User’s Manual: Versions 3.0 and 4.0.5 (page 3 and especially page 6 - beginning at line 2). The Declaration refers to numerous pages in the two STK manuals, thus rendering such disclosure essential. In so far as it would be a

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financial burden for the public to obtain copies of the software, said originally incorporated material must remain incorporated and, because it consists of non-patent literature, must be physically incorporated.

32. Applicants are correct that it is *undue experimentation* that is the critical issue, *as the Examiner explained to Applicants during the interview*. Applicant's basic argument is that the Declaration resolves any questions of enablement. However, as explained earlier, the Examiner has carefully considered the arguments in the Declaration but they are not persuasive. In general, the Declaration refers to only 2-3 lines in various sections of the application. The Examiner has carefully considered the indicated material but is not persuaded. This is insufficient detail. At the same time the Declaration refers to numerous pages in the two STK manuals. It is noted that the Declaration relies, in part, upon the STK User's Manual: Versions 3.0 and 4.0.5 (page 3 and especially page 6 - beginning at line 2), thus rendering such disclosure essential.

Response to Argument - Claim Interpretation

33. Applicant's arguments filed 4/22/2003 have been fully considered but they are not persuasive. Applicants have recited a few examples of court decisions but have only provided conclusory arguments about their relevance to the instant situation.

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Response to Argument - 102 Rejections

34. Applicant's arguments filed 4/22/2003 have been fully considered but they are not persuasive.

35. Applicant's arguments against the 102(a) rejections are based on lines 14-18 (page 2) of the Declaration, which recites:

“The subject matter disclosed and claimed in the ‘760 application that has been implemented in STK was invented by me together with my co-inventors Douglas Claffey and Deron Ohlarik, not by others.

We discovered this invention in the ordinary course of our employment by Analytical Graphics, Inc.”

36. The above statement is not persuasive for the following reasons. Claims 1-18, (and 19-22 which have been subsequently cancelled) 23-26 and 30-35 were rejected under 35 U.S.C. 102(a) as being clearly anticipated by STK version 3.0 or STK version 4.0.5 or “Sensor Obscuration Tool (STK/Advanced VO)”. Applicants have stated that (first full paragraph, paper # 8):

“At the time of filing of this application, the invention was already being sold to customers as part of a working software product.”

37. Applicants still have not stated whether the listed inventors are responsible for the *cited versions of the working software product*, but instead have only stated that they invented the *claimed invention*.

38. Claims 1-18, 23-26 and 30-35 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by STK version 3.0 or STK version 4.0.5 or “Sensor Obscuration Tool (STK/Advanced VO)”. Applicants have stated that (first full paragraph, paper # 8):

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“At the time of filing of this application, the invention was already being sold to customers as part of a working software product.” Applicants have not stated when the cited versions were on sale.

39. Applicant’s arguments against the 102(b) rejections are based on lines 7-13 (page 2) of the Declaration, which recites:

“No sale or offer of sale, of a version of STK implementing the subject matter disclosed and claimed in the ‘760 application occurred more than one year prior to the June 14, 1999 filing date of the ‘760 application.”

40. The above statement is not persuasive for the following reasons. Claims 1-18, (and 19-22 which have been subsequently cancelled) 23-26 and 30-35 were rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. Applicants have stated that (first full paragraph, paper # 8):

“At the time of filing of this application, the invention was already being sold to customers as part of a working software product.” Applicants still have not stated when the cited versions were on sale and whether the listed inventors are responsible for the cited versions of the *specific* working software product, but instead have only stated that they invented the *claimed invention*.

41. Applicant’s arguments against the 102(f) rejections are based on lines 14-18 (page 2) of the Declaration, which recites:

“The subject matter disclosed and claimed in the ‘760 application that has been implemented in STK was invented by me together with my co-inventors Douglas Claffey and Deron Ohlarik, not by others. We discovered this invention in the ordinary course of our employment by Analytical Graphics, Inc.”

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42. The above statement is not persuasive for the following reasons. Claims 1-18, (and 19-22 which have been subsequently cancelled) 23-26 and 30-35 were rejected under 35 U.S.C. 102(f) as being clearly anticipated by STK version 3.0 or STK version 4.0.5 or "Sensor Obscuration Tool (STK/Advanced VO)". Applicants have stated that (first full paragraph, paper # 8):

"At the time of filing of this application, the invention was already being sold to customers as part of a working software product."

- However, Applicants still have not stated whether the listed inventors are responsible for the *cited versions of the specific working software product*, but instead have only stated that they invented the *claimed invention*.

Response to Argument - 103 Rejections

43. Applicant's arguments filed 4/22/2003 have been fully considered but they are not persuasive.

44. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

45. Note that the reference to the declaration has been withdrawn. However, this does not change the basis of the 103 rejections. The same summary of the '489 patent was also noted independently by the Examiner (Claffey et al. disclose *a three-dimensional visualization wherein the general*

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concept of how to carry out object selection is taught (col. 3, lines 54-59); how to assign a color to selected relevant objects, while another color is assigned to irrelevant objects and background (col. 3, lines 49-55). ...”).

Examiner's Recommendation

46. The prior art and 112(1) issues can be traversed as follows:

1) supply the required documents (as per 37 C.F.R. 1.105) so that the Examiner may review the documents and to ensure that they do not qualify as prior art.

2) ***Amend the specification to include the previously incorporated material.*** The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Conclusion

47. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 4/22/2003 prompted the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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48. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

49. Any inquiry concerning this communication or earlier communications from the examiner should be:

directed to: Dr. Hugh Jones telephone number (703) 305-0023, Monday-Thursday 0830 to 0700 ET, *or* the examiner's supervisor, Kevin Teska, telephone number (703) 305-9704. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, telephone number (703) 305-3900.

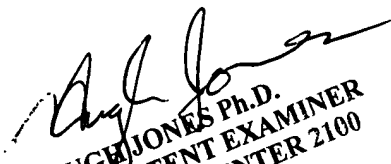
mailed to: Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to: (703) 308-9051 (for formal communications intended for entry) *or*
(703) 308-1396 (for informal or draft communications, please label "*PROPOSED*"
or "*DRAFT*").

Dr. Hugh Jones

Primary Patent Examiner

July 13, 2003


HUGH JONES Ph.D.
PRIMARY PATENT EXAMINER
TECHNOLOGY CENTER 2100

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DETAILED ACTION

Requirement for Information - 37 C.F.R. § 1.105

1. In response to a 1.105 request for information, Applicants provided the Copyright Registration Certificates TX4-819-011, TX4--819-009 and TX4-819-010. However, it is noted that only the first and last 25 pages are provided.
2. Page 19 of the '009, pages 20-21 of the '011 and pages 19-20 of the '010 Registration disclose an "obstruction" software routine that appears to disclose the claimed invention. The text indicates that the software routine is very relevant and appears to be *essential* to the instant invention and claims, and therefore the applicant should provide the office with copies of any material pertaining to Satellite Tool Kit systems analysis program, cert. Nos. TX4-819-009, TX4-819-010 and TX4-819-011 that discloses the "obstruction" teaching so that they may further be evaluated for relevance.
3. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

- the "obstruction" software routine as disclosed in Satellite Tool Kit systems analysis program, cert. Nos. TX4-819-009, TX4-819-010 and TX4-819-011.

4. An issue of public use or on sale activity has been raised in this application (page 3, paper # 6; page 23, paper # 8). The three publication dates of the three Registrations also indicate that the art may qualify as 102(b) prior art. In order for the examiner to properly consider patentability

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of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows:

- the "obstruction" software routine as disclosed in Satellite Tool Kit systems analysis program, cert. Nos. TX4-819-009, TX4-819-010 and TX4-819-011.

5. **In response to this requirement, please provide the names of any products or services that have incorporated the claimed subject matter.**

6. **The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement.** This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

7. **The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56.** Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item. Applicants are reminded that they have referred to the material in the specification and have relied upon the material in a declaration in order to attempt to traverse 112(1) rejections.

Art Unit: 2123

8. **This requirement is an attachment of the enclosed Office action.** A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

9. **Any inquiry concerning this communication or earlier communications from the examiner should be:**

directed to: Dr. Hugh Jones telephone number (703) 305-0023, Monday-Thursday 0830 to 0700 ET, *or* the examiner's supervisor, Kevin Teska, telephone number (703) 305-9704. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, telephone number (703) 305-3900.

mailed to: Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to: (703) 308-9051 (for formal communications intended for entry) *or*


(703) 308-1396 (for informal or draft communications, please label "*PROPOSED*")

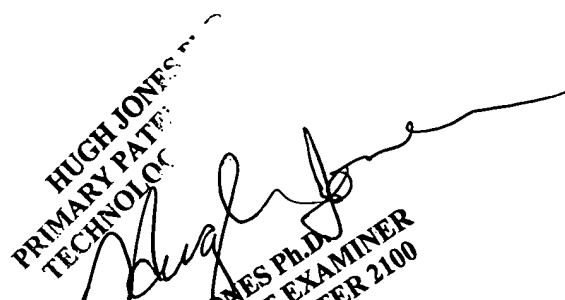
or "DRAFT").

Dr. Hugh Jones

Primary Patent Examiner

July 13, 2003


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